REMARKS

Amendments to the specification have been made to correct minor typographical and grammatical errors.

Claims 1-5 and 9-11 are amended to correct antecedent issues.

5 Claims 12-25 are rejected under 35 U.S.C. § 101.

Claims 1-16 are rejected under 35 U.S.C. § 112.

Claims 21-23 rejected under 35 U.S.C. § 102(b).

Claims 1-5, 7-11, 17, 18, and 20 rejected under 35 U.S.C. § 102(a).

Claims 1-25 remain in this application.

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35 U.S.C. §101

Claims 12-25 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subjected matter. Reconsideration is requested.

Claims 12-16 are particularly rejected as "a product for perfoming a

15 process, not a specific machine or manufacture defined by structure".

Independent claim 12 recites "[a] system comprising:

a marketing database that stores customer information for multiple customers, the customer information including information on printing devices and printing device replaceable components used by the customers;

20 a recycling center to receive a used printing device replaceable component with component memory from a printing device of a customer, and to retrieve printing device data from the component memory and store the printing device data in the marketing database; and

a marketing center configured to search the marketing database for

25 printing devices having printing device data associated therewith that meet

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certain search criteria, and to apply marketing solutions for printing devices identified by a search."

Contrary to the Office's position, the specification describes the "system" of claim 12, beginning on page 7 line 14 of the specification in reference to Fig. 2

5   of the drawings. Applicants respectfully request that the §101 rejection of claim 12 be withdrawn.

Claims 13-16 are dependent on claim 12 and are directed to a "system" as well. Applicants respectfully request that the §101 rejection of claims 13-16 be withdrawn.

10   **Independent claim 17** recites "[a] method for marketing products to customers, comprising:

searching a marketing database for a printing device or printing device replaceable component that meets certain search criteria, the marketing database storing printing device data that has been retrieved from

15   component memory of a printing device replaceable component used in a printing device;

identifying a customer that uses the printing device; and

distributing marketing information to the customer, the marketing information advertising products associated with customer use of the

20   printing device or printing device replaceable component."

The Office argues that the claims 17-20 "do not involve a practical application in the technological arts" and that "A practical application is one that has a useful, concrete and tangible result." The Office admits that "distributing marketing information (to the customer) is a useful result, however, the marketing

25   information recited in the claims is not concrete and tangible."

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Applicants disagree with the Office's argument. Claim 17 particularly recites "the marketing information advertising products associated with customer use of the printing device or printing device replaceable component". The marketing information provides for particular (concrete and tangible) information

5   (result), specifically products associated with the customer use of the printing device or printing device replaceable component. Applicants respectfully request that the §101 rejection of claim 17 be withdrawn.

Claims 18-20 are dependent on claim 17 and are also directed to a "system". Applicants respectfully request that the §101 rejection of claims 18-20

10   be withdrawn.

Independent claim 21 recites "[a] marketing database stored on one or more computer-readable media, the database comprising a plurality of records, *each record* further comprising:

    a product identifier field that contains a value that uniquely identifies

15   a product;

    a customer identifier field that contains a value that uniquely identifies a customer that uses the product identified in the product identifier field;

    a usage data field that contains usage data that indicates how the

20   product identified in the product identifier field is used by the customer identified in the customer identifier field; and

    a marketing solution field that contains a marketing solution that is to be applied to the customer identified in the customer identifier field if the usage data meets certain usage criteria."

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The Office argues that the claims 21-25 "recite data stored in a database" and that the "data does not impart any functionality to either the data as claimed or to the computer database".

Applicants present that claim 21 is directed to "each record" that comprise

5   the database, and not to data. Claim 21 particularly recites a data structure claim that is described in the specification beginning on page 10 line 21 referencing Fig. 3 and specifically record 302 as an example. Claims written as data structure claims are acceptable, as decided in *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994). Applicants respectfully request that the §101 rejection of claim 21 be withdrawn.

10   **Claims 22-25** are dependent on claim 21 and are also directed to a data structure (i.e., record). Applicants respectfully request that the §101 rejection of claims 22-25 be withdrawn.

35 U.S.C. §112

15   Claims 1-16 are rejected under 35 U.S.C. § 112. Reconsideration is requested.

Claims 1-5, 9-11 have been amended to distinguish between the claimed "printing devices". Applicants request that the §112 rejection of claims 1-11 be withdrawn.

20   As discussed above in regards to the §101 rejection of claim 12, claim 12 is directed to a system. The system of claim 12 includes the elements of a "marketing database", a "recycling database" and a "marketing center". The Office presents that "it is unclear from the claim whether the centers include a facility containing persons or whether the centers are computer structure alone."

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The role of the claims is not to explain the invention. "The purpose of claims is not to explain the technology or how it works, but to state the legal boundaries of the patent grant. A claim is not 'indefinite' simply because it (the claim) is hard to understand when viewed without benefit of the specification."

5   Autogiro Co. of America v. United States, 384 F.2d 391, 397, 155 USPQ 697, 701 (Ct. Cl. 1967).

It is respectfully submitted that failure to fully describe aspects of an invention in the claims is not a proper basis for a §112 rejection. The specification clearly explains the concepts questioned by the Examiner. Applicants request that

10   the §112 rejection of claim 12 be withdrawn.

Claims 13-16 are dependent on claim 12 and are directed to a "system", and benefit from the arguments presented in support of claim 12. Applicants request that the §112 rejection of claims 13-16 be withdrawn.

15   <u>35 U.S.C. §102</u>

Claims 21-23 are rejected under 35 U.S.C. §102(b) as being anticipated by the article "Who's Winning the Information Revolution" by Myron Magnet (Fortune, November 30, 1992), hereinafter referred to as "Magnet". Reconsideration is requested.

20   **Independent claim 21** recites "[a] marketing database stored on one or more computer-readable media, the database comprising a plurality of records, each record further comprising:

a product identifier field that contains a value that uniquely identifies

a product;

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a customer identifier field that contains a value that uniquely identifies a customer that uses the product identified in the product identifier field;

a usage data field that contains usage data that indicates how the product identified in the product identifier field is used by the customer identified in the customer identifier field; and

a marketing solution field that contains a marketing solution that is to be applied to the customer identified in the customer identifier field if the usage data meets certain usage criteria."

Magnet is cited as disclosing "a marketing system that includes a coupon to a customer based on the customer's use". The Office further states that "it is inherent in the system that it includes a database having fields that contain data about the product, data about the customer and data about the marketing solution".

Magnet discloses a marketing system that issues coupons as promotions. Customers receiving such coupons may or my not elect to use the coupons. The use of such coupons is indicative of customers' preferences. Magnet, however, fails to disclose or teach the "record" data structure recited in claim 21.

In particular, Magnet fails to disclose or teach the elements of "a product identifier field ...; a customer identifier field ...; a usage data field ...; and a marketing solution field" as recited in claim 21. The Office does not point to where such elements are taught or disclosed in Magnet.

Magnet fails to show each and every element of claim 21. Accordingly, Applicants respectfully request that the §102 rejection of claim 21 be withdrawn.

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Dependent claims 22-23 are allowable at the least by virtue of their dependency on base claim 21. Applicants respectfully request that the §102 rejection of claims 22-23 be withdrawn.

5   ## 35 U.S.C. §103

Claims 1-5, 7-11, 17, 18, 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of U.S. Patent No. 5,789,732 McMahon et al (McMahon) in view of U.S. Patent No. 5,835,817 to Bullock et al (Bullock). Reconsideration is requested.

10   **Amended independent claim 1** recites "[a] method comprising:

retrieving printing device data from component memory on a replaceable component used in a first printing device;

storing the printing device data in a marketing database;

associating the printing device data with the first printing device;

15   searching the marketing database for a second printing device that meets certain search criteria; and

applying a pre-determined marketing solution for the second printing device found to meet the search criteria."

McMahon teaches a Consumer Data Device that is comprised of a plastic

20   encased, credit card size case containing a memory for data and transaction retention (see Summary of McMahon).

The Office presents that McMahon teaches "associating the data with a product (purchasing history of the consumer)". The Office also presents that McMahon teaches "searching the database for the product (coupon and

25   promotional discount opportunities that can be used in the current visit).

Furthermore, it is also presented by the Office that McMahon teaches "applying a predetermined marketing solution (download coupon and promotional discount opportunities that are redeemed at the point of sale).

McMahon fails to teach or suggest the "associating the printing device data

5   with the first printing device" as recited in claim 1. Purchasing history of the consumer as taught in McMahon is too general and does not specify (associate) data to a particular product such as a first printer. McMahon fails to teach or suggest "searching the marketing database for a second printing device that meets certain search criteria" as recited in claim 1. McMahon teaches creating coupon

10   and promotional discount activities; however, no second product (printer device) is searched based on certain search criteria. Furthermore, McMahon fails to teach or suggest "applying a pre-determined marketing solution for the second printing device found to meet the search criteria", since a second product (printing device) is not particularly searched for.

15   Bullock is cited for its teaching of "a printing device component that is replaceable and has a memory chip that stores information related to the usage of the device"

Bullock provides no assistance in light of McMahon as to the recited method of claim 1. Since McMahon does not teach "associating the printing

20   device data with the first printing device; searching the marketing database for a second printing device that meets certain search criteria; and applying a pre-determined marketing solution for the second printing device found to meet the search criteria", it would not have been obvious to combine the "a printing device component" taught by Bullock.

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Accordingly, a combination of McMahon and Bullock is improper. Applicants respectfully request that the §103 rejection of claim 1 be withdrawn.

Dependent claims 4-5, 7-11 are allowable at the least by virtue of their dependency on base claim 1. Applicants respectfully request that the §103

5 rejection of claims 4-5, 7-11 be withdrawn.

Independent claim 17 recites "[a] method for marketing products to customers, comprising:

searching a marketing database for a printing device or printing device replaceable component that meets certain search criteria, the

10 marketing database storing printing device data that has been retrieved from component memory of a printing device replaceable component used in a printing device;

identifying a customer that uses the printing device; and

distributing marketing information to the customer, the marketing

15 information advertising products associated with customer use of the printing device or printing device replaceable component."

As discussed above in support of claim 1, McMahon teaches a purchasing history of a consumer, but fails to teach or suggest "searching a marketing database for a printing device or printing device replaceable component (i.e.,

20 particular product) that meets certain search criteria" as recited in claim 17.

Bullock provides no assistance in light of McMahon as to the recited method of claim 17. Since McMahon does not teach "searching a marketing database for a printing device or printing device replaceable component that meets certain search criteria", it would not have been obvious to combine the "a printing

25 device component" taught by Bullock.

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Accordingly, a combination of McMahon and Bullock is improper. Applicants respectfully request that the §103 rejection of claim 17 be withdrawn.

Dependent claims 18 and 20 are allowable at the least by virtue of their dependency on base claim 17. Applicants respectfully request that the §103

5   rejection of claims 18 and 20 be withdrawn.

Claims 6 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of McMahon and Bullock, in further view of U.S. Patent No. 5,625,816 to Burdick et al (Birdick). Reconsideration is requested.

10   **Dependent claim 6** depends on claim 1 and benefits from the arguments in support of claim 1, and therefore is allowable at the least by virtue of its dependency on claim 1. Applicants respectfully request that the §103 rejection of claim 6 be withdrawn.

Dependent claim 19 depends on claim 17 and benefits from the arguments

15   in support of claim 17, and therefore is allowable at the least by virtue of its dependency on claim 17. Applicants respectfully request that the §103 rejection of claim 19 be withdrawn.

Claims 12 and 14-16 are rejected under 35 U.S.C. §103(a) as being

20   unpatentable Bullock. Reconsideration is requested.

Independent claim 12 recites "[a] system, comprising:

a marketing database that stores customer information for multiple customers, the customer information including information on printing devices and printing device replaceable components used by the customers;

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a recycling center to receive a used printing device replaceable component with component memory from a printing device of a customer, and to retrieve printing device data from the component memory and store the printing device data in the marketing database; and

5   a marketing center configured to search the marketing database for printing devices having printing device data associated therewith that meet certain search criteria, and to apply marketing solutions for printing devices identified by a search."

Bullock teaches a printer/copier apparatus to receive a replacement ink

10   cartridge that is employed during the printing/copying operation. The cartridge includes a connector which mates with another connector coupled to a processor, and a serial access memory. Data transfers are enabled both from and to the memory to enable access and modification of data stored therein that is indicative of cartridge usage, calibration, and to parameters for controlling operation of the

15   apparatus. (See abstract of Bullock). Bullock teaches a mail in program where a manufacturer receives used cartridges. The memory of the used cartridges may be used to gather information as to how the cartridges are being used. (See Bullock, col. 7, lines 58-61).

Bullock fails to teach or suggest "a marketing database that stores customer

20   information for multiple customers, the customer information including information on printing devices and printing device replaceable components used by the customers". From the mail-in program that is taught in Bullock, the Office assumes that a marketing database is kept that stores customer information for multiple customers; however, there is no teaching or suggestion in Bullock of such

25   a database that stores customer information.

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Bullock further fails to teach or suggest "a marketing center configured to search the marketing database for printing devices having printing device data associated therewith that meet certain search criteria, and to apply marketing solutions for printing devices identified by a search." Although the Office

5 presents that "the marketing center database is searched for criteria to optimize parameters on the cartridge chip which is a type of marketing solution and quality control ...", the Office fails to point out where in Bullock it is taught or suggested "to search the marketing database for printing devices having printing device data associated therewith that meet certain search criteria" as recited in claim 12.

10 Accordingly, Bullock fails to teach or suggest claim 12. Applicants respectfully request that the §103 rejection of claim 12 be withdrawn.

Dependent claims 14-16 are allowable at the least by virtue of their dependency on base claim 12. Applicants respectfully request that the §103 rejection of claims 14-16 be withdrawn.

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Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Bullock as applied to claim 12 above, in further view of McMahon.

Dependent claim 13 depends on claim 12 and benefits from the arguments

20 in support of claim 12, and therefore is allowable at the least by virtue of its dependency on claim 12. Applicants respectfully request that the §103 rejection of claim 13 be withdrawn.

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CONCLUSION

All pending claims 1-25 are in condition for allowance. Applicants respectfully request reconsideration and prompt issuance of the subject application. If any issues remain that prevent issuance of this application, the

5   Examiner is urged to contact the undersigned attorney before issuing a subsequent Action.
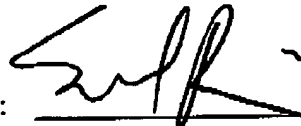
Respectfully Submitted,

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